

Appl. No. 10/799,464 of Sbalich et al.
Atty. Dkt. No. ZM466-04004

REMARKS

The Office Action dated September 28, 2005 provided a three-month statutory period for reply. This response is being filed on December 28, 2005. Therefore, applicant calculates no fees due with this correspondence.

Reconsideration of the instant application and appurtenant claims is hereby respectfully requested in light of the following arguments.

Amendments to the Claims

There are no amendments to the claims.

Rejections under 35 U.S.C. § 102(b)

Claims 16, 29, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Canadian Application 2,277,645 to Cheng, hereinafter referred to as Cheng. Specifically, with respect to claim 16 it is asserted that Cheng teaches a motion detector 2 having a single spherical lens and a downwardly directed 360-degree range viewing field (a spherical translucent cap 24, at Fig. 4 and page 6, lines 2-13), a lamp shade 12, a base plate 11, and further that the motion detector 22 is mounted to the base plate (via an extended rod 31) and the lamp housing includes an aperture through which the spherical lens extends (the lamp housing includes an aperture for the translucent lens cap 24 threaded onto the outer surface 23 of motion detector 22).

Applicant respectfully traverses this ground of rejection for the following reasons. Initially, applicant notes that a claim rejection under 35 U.S.C. 102(b) requires the reference cited in the rejection to include each and every limitation of the rejected claim. Applicant's claim 16 requires a motion detector having a spherical lens and a motion sensor, and further that the lamp housing has an aperture through which the spherical lens

Appl. No. 10/799,464 of Sibalich et al.
Atty. Dkt. No. ZM466-04004

extends. It is asserted that Cheng teaches a motion sensor having a spherical lens since Cheng discloses a translucent cap 24 at Fig. 4 and page 6 lines 2-13. However, applicant can find no teaching in Cheng of a motion detector having a spherical lens. Cheng simply discloses the use of a motion detector 22 having a threaded inner hole 30 that mates with threads on a rod 31, in contradistinction to a motion detector that is mounted to a base plate as required by claim 16. (See Cheng, Fig. 1 and page 5 lines 4-9) In fact, in all the drawing views of Cheng the motion detector 22 and translucent cap 24 are shown as having flat ends rather than spherical portions, as best shown in Fig. 4.

Translucent cap 24 is described at page 6 lines 2-9 (and shown at Figs. 3A and 3B) as being a removable threaded cap having a translucent central portion 33 which is raised somewhat above the circumference 24 of cap 24 to allow the motion detector 22 to sense motion through the cap 24. As seen in Figs. 3A and B, the cap 24 is not at all spherical in shape, nor could it be considered a lens of the motion detector. Furthermore, the cap 24 of Cheng screws onto a threaded portion of the lamp, in contradistinction to applicant's claim 16 limitation of a spherical lens that protrudes through a hollow recess.

Accordingly, since Cheng does not teach each limitation of claim 16 of the instant application, claim 16 can not be properly rejected under 35 U.S.C. 102(b).

Regarding claim 29, it is asserted that "all the claimed subject matters are cited in respect to claim 16 above, and including the bottom panel having a hollow recess (the lamp housing 12 having an aperture for the spherical lens cap 24 of the motion detector 22 protrude through the lamp housing 12, see Figs. 1 and 4)." Initially, applicant notes that claim 29 requires a lamp shade having a support frame and a frame base framing a bottom panel and a plurality of side panels, said bottom panel having a hollow recess.

Appl. No. 10/799,464 of Sibalich et al.
Atty. Dkt. No. ZM466-04004

The Examiner has apparently asserted that the aperture of Cheng, over which the cap 24 may be threaded, is equivalent to the hollow recess of the bottom panel of claim 29.

However, applicant contends that the hollow recess cited in claim 29 is a recess within the bottom panel of a frame base, not the aperture in the lamp shade itself.

Furthermore, it is not asserted where in the Cheng reference the limitations of a support frame, frame base, side panels and bottom panel are taught, as required by claim 29.

Applicant can find no teaching in the Cheng application of a support frame or frame base, nor is any asserted in the instant ground of rejection. Accordingly, since Cheng does not teach each limitation of claim 29 of the instant application, claim 29 can not be properly rejected under 35 U.S.C. 102(b).

Claim 31 has been rejected under 35 U.S.C. 102(b) as being anticipated by Cheng for all the reasons set forth with respect to claim 29, as discussed above. However, and as discussed in some detail herein above with respect to claim 16, the Cheng reference does not teach or disclose a motion detector assembly having a spherical lens as required by claim 31. Additionally, applicant notes in passing that claim 31 requires a motion detector assembly to be mounted to the base plate. However, the Cheng reference suspends the motion detector from a threaded rod 31, in contradistinction to the limitations of claim 31. Accordingly, for all the reasons set forth above regarding claim 16, claim 31 can not be anticipated by Cheng under 35 U.S.C. 102(b).

Finally, claim 32 stands rejected as anticipated by Cheng under 35 U.S.C. 102(b) for all the reasons set forth herein above regarding claim 29. Applicant reiterates their earlier argument that the Cheng reference does not teach or disclose a motion detector assembly

Appl. No. 10/799,464 of Sibalich et al.
Atty. Dkt. No. ZM466-04004

having a spherical lens as required by claim 32. Accordingly, claim 32 can not be anticipated by Cheng under 35 U.S.C. 102(b).

Rejections under 35 U.S.C. § 103(a)

Claims 1-10 stand rejected under 35 USC § 103(a) as being unpatentable over Cheng in view of Batko (U.S. Patent No. 6,151,529, hereinafter "Batko"), and Chien (U.S. Patent No. 6,168,282, hereinafter "Chien").

The rejection of a claim or claims of a patent application under 35 USC §103 (a) requires the establishment of a prima facie case of obviousness as that term is understood and applied by courts of competent jurisdiction. Prima facie obviousness encompasses three basic criteria: there must be some suggestion or motivation in the references cited or in the knowledge available to one of ordinary skill in the art to modify the references or combine the teachings thereof to arrive at the claimed invention; there must be a reasonable expectation of success in doing so; and finally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Furthermore, the fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F. 2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Initially, regarding independent claim 1 the Examiner has asserted that Cheng teaches many of the elements of claim 1 (as discussed with respect to claim 29) but fails to disclose the motion detector connected to a printed circuit board, wherein the printed circuit board, a sensitivity regulating switch, a time regulating switch, and a switch cover are enveloped within a motion detector case. The Examiner additionally recites Batko as

Appl. No. 10/799,464 of Sibalich et al.
Atty. Dkt. No. ZM466-04004

disclosing "a switching system 10 for manually or automatically controls (sic) to operate a motion sensor and lights including a printed circuit board 46, a microprocessor 70, a timing mode, motion sensitivity adjustment 76 and photocell sensor 82". It is then asserted that it would have been obvious to one skilled in the art at the time the invention was made to add or implement the switching system of Batko to the circuitry of the motion detector of Cheng in order to "increasing the efficiency and reliability operation functions of the combination between light and motion detector because Chien suggest that the conventional or integrated control type circuits and switches including dimmer, timer and photo-sensor for operating the combinations of light and motion sensor are known, and can be added to the light fixture by simply connecting them to the appropriate terminals of the electro-luminescent lighting element and power supply contacts/wires". It is not explained in this ground of rejection how this reasoning specifically applies to the limitations of claim 1.

Initially, applicant notes that the Examiner specifically states that Cheng fails to disclose a motion detector case enveloping the printed circuit board, the sensitivity regulating switch, the time regulating switch, and the switch cover. The Examiner then cites Batko and/or Chien for the implementation of switching circuitry to the light and motion detector. After thorough review, applicant can not find, either in the instant office action, or in the Batko and Chien references, any disclosure or teaching of a motion detector case for protecting the printed circuit board, sensitivity regulating switch, time regulating switch and switch cover. Accordingly, since Batko and Chien do not teach or disclose a motion detector case, and since Cheng does not teach said case by the Examiner's admission, the cited combination of references do not teach or suggest each

Appl. No. 10/799,464 of Sibalich et al.
Atty. Dkt. No. ZM466-04004

limitation of applicant's claim 1 as required for an obviousness rejection. Accordingly, claim 1 can not be properly rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and/or Chien.

Claims 2 – 7 each depend from claim 1, or from a claim that depends from claim 1. Accordingly, since each of these claims contain the limitation of a motion detector case, and further since each of these claims has been rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and Chien, applicant notes that these claims can not properly rejected as obvious under 35 U.S.C. 103(a) for all the reasons set forth with respect to claim 1 herein above.

Claim 8 has also been rejected as being obvious under 35 U.S.C 103(a) over Cheng in view of Batko and Chien, including the rubber plug and an extension cylinder, as shown in Fig. 4 of Cheng. Initially, applicant asserts that no reference cited in the instant office action teaches the use of a rubber plug for mounting a motion detector case. Additionally, the applicant notes that independent claim 8 also contains the limitation of a motion detector case mounted on a rubber plug. Accordingly, the reasoning set forth herein above with respect to independent claim 1 is equally applicable to claim 8, namely that the combination of references cited against claim 8 simply do not teach a motion detector case as required thereby. Accordingly, claim 8 can not be properly rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and/or Chien.

Regarding claims 11-15, each of these claims has been rejected as being obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and/or Chien. However, since each of these claims depends from independent claim 8, and since claim 8 can not be obvious over this combination of references as discussed herein above, claims 11-15 also can not

Appl. No. 10/799,464 of Sibllich et al.
Atty. Dkt. No. ZM466-04004

be rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and/or Chien, since the cited reference combination does not teach a motion detector case.

Independent claim 17 stands rejected as being obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and Chien for the same reasons set forth with respect to claims 1 and 3, discussed above. However, applicant notes that independent claim 17 includes the limitation of a motion detector having a spherical lens protruding through an opening in a lamp shade assembly, as discussed in some detail herein above with respect to claim 16. Specifically, applicant notes that none of the references cited herein teach or disclose a motion detector having a spherical lens, as required by claim 17, since neither Batko or Chien discuss specific motion sensor embodiments. Accordingly, since the spherical lens limitation of claim 17 is not taught by the combination of references cited, claim 17 can not be rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and/or Chien.

Claim 18 also stands rejected as being obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and Chien for the same reasons set forth with respect to claims 17. Accordingly, for those reasons set forth herein above regarding claim 17, claim 18 can not be rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and/or Chien.

Claim 19 stands rejected as being obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and Chien for the same reasons set forth with respect to claims 1 and 17. However, applicant points out that claim 19 contains the further limitation of a motion detector case enveloping the printed circuit board assembly. As discussed in detail above with respect to claim 1 and its dependent claims, the combination of Cheng, Batko and

Appl. No. 107/99,464 of Sibalich et al.
Atty. Dkt. No. ZM466-04004

Chien simply do not teach or disclose a motion detector case and as such, do not teach every limitation of claim 19 of the instant application. For these reasons claim 19 can not be rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and/or Chien.

Claim 20 stands rejected as being obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and Chien for the same reasons set forth with respect to claims 1 and 17. However, claim 20 depends from claim 17 and includes the further limitation of a heat sink encircling said spherical lens of said motion detector. The instant office action does not provide the recitation of a heat sink encircling said spherical lens in any reference cited herein. Since this limitation is completely absent from the cited combination and indeed absent from the ground of rejection, claim 20 can not be rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and/or Chien, since these references do not teach each and every element of the claim.

Claim 21 stands rejected as being obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and Chien for the same reasons set forth with respect to claims 8 and 17.

Claim 21 depends from claim 17 and recites the further limitation of a rubber plug and an extension cylinder positioned between the printed circuit board assembly and a heat shield, wherein the extension cylinder is removably mounted to the base plate. Applicant notes that while the Cheng reference does disclose a rod 31 it does not disclose either an extension cylinder, or a rubber plug to inhibit the entry of moisture and the like, as required by claim 21. Furthermore, neither Cheng nor Batko disclose these features of applicant's claim 21. Accordingly, since the limitation of a rubber plug and extension cylinder is not taught or suggested by the combination of references cited, claim 21 can

Appl. No. 10/799,464 of Sibalich et al.
Atty. Dkt. No. ZM466-04004

not be rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and/or Chien.

Claim 22 stands rejected as being obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and Chien for the same reasons set forth with respect to claims 14 and 17. However, claim 22, which depends from claim 17, claims the further limitation of a partition 45 positioned between a printed circuit board assembly and said spherical lens as best seen in Figs. 3 and 6 of the instant application. Applicant respectfully asserts that Cheng, Batko and Chien simply do not teach this feature of the applicant's invention. In fact applicant can find no disclosure in the references cited for the use of a partition between the spherical lens of a motion detector and a printed circuit board on which the detector is mounted. Since Cheng, Batko and Chien do not teach each limitation of claim 22, this claim can not be rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and/or Chien.

Claims 26-28 also stand rejected as being obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and Chien. Applicant notes that claims 26-28 depend from claim 17. As discussed herein above, applicant believes claim 17 to be patentable over the references cited in this ground of rejection, and since claims 26-28 contain all the limitations of claim 17, the reasoning herein above regarding that claim is equally applicable to claims 26-28. Accordingly, claims 26-28 can not be rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and/or Chien for the same reasons as discussed in detail herein above with respect to claim 17.

Claim 30 also stands rejected as being obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and Chien. Claim 30 depends from independent claim 29 and

Appl. No. 10/799,464 of Silbalich et al.
Atty. Dkr. No. ZM466-04004

includes all the limitations thereof, including a lamp shade having a support frame and a frame base framing a bottom panel and a plurality of side panels, said bottom panel having a hollow recess therein. Claim 30 adds the further limitation of a motion detector case to independent claim 29. As discussed in some detail herein above, no reference cited in the instant office action teaches the limitation of a motion detector case as required by claim 30. Furthermore, neither Cheng, Batko, nor Chien teaches the limitation of a lamp shade having a support frame and a frame base framing bottom and side panels as required by claim 30. In fact, it is not asserted in the instant office action where this limitation may be found in the prior art. Accordingly, since these limitations are not taught or disclosed by the combination of references cited, claim 29 can not be rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and/or Chien.

Claim 33 also stands rejected as being obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and Chien. Claim 33 is an independent claim that includes the limitation of a motion detector electronically connected to a photocell and further having a dual light capability, said light emitting light at a lower luminance during a first condition and at a higher luminance when said motion sensor is activated. Based on this limitation, applicant can find no assertion in the instant office action of such features in the references cited. Neither Cheng, Batko, nor Chien teaches the limitation of a photocell having dual light capability electronically connected to a motion detector, in combination with the remaining elements of claim 33. Since these limitations are not taught or disclosed by the combination of references cited, claim 33 can not be rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Batko and/or Chien.

Appl. No. 10/799,464 of Sibalich et al.
Atty. Dkt. No. ZM466-04004

Claims 5, 9, 10 and 23-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng, Batko, Chien and further in view of Haslam et al. (U.S. Patent No. 5,590,953, hereinafter "Haslam"). Specifically, regarding claim 5 the Examiner asserts that while Cheng fails to disclose the lamp shade comprising a support frame and frame base supporting a plurality of glass panels, it does disclose a decorative ring encircling said hollow recess, that being the translucent cap 24 of Cheng. However, the Examiner has asserted previously in the office action that translucent cap 24 is in fact a lens of some sort for the motion detector, in direct contradistinction to the assertion that translucent cap 24 is a decorative ring, as set forth in this ground of rejection.

Additionally, it is asserted that Haslam suggests that a motion activated decorative lantern 20 having a single optical glass lens and/or a plurality of optical glass lenses mounted on a frame can be combined with the teachings of Cheng, Batko, and Chien to arrive at the limitations of applicant's claim 5. (See Haslam Figs. 15 and 16). However, applicant points out that claim 5 depends from claim 1, and includes the limitations thereof. Specifically, applicant contends that none of these references teach or suggest the motion detector case enveloping the printed circuit board, sensitivity regulating switch, time regulating switch and switch cover as required by claim 5. Haslam does not disclose, teach, or suggest this limitation of claim 5, nor do Cheng, Batko, or Chien as discussed in some detail herein above. Since this limitation (the detector case) is not taught or disclosed by the combination of references cited, and further since the ring encircling the hollow recess is not taught by the cited combination of references, claim 5 can not be rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Batko, Chien and further in view of Haslam.

Appl. No. 10/799,464 of Sibalich et al.
Atty. Dkt. No. 2M466-04004

Claim 9 also stands rejected as being obvious under 35 U.S.C. 103(a) over Cheng in view of Batko, Chien and Haslam for the reasons set forth with respect to claims 5 and 8. Applicant once again observes that claim 9 includes the claim 8 limitation of a motion detector case for protecting the printed circuit board and ancillary elements is not taught by the combination of references cited, as set forth in some detail herein above.

Applicant further notes that while Haslam does depict a light fixture having multiple glass panels therein, it does not teach or suggest a frame base framing a bottom panel and mounted to a base plate as required by claim 9, but rather an upper flange 102 to which a decorative lamp portion 22 is secured. Applicant further notes that claim 9 requires the motion detector assembly to be mounted to the base plate and positioned within the lamp shade, in contradistinction to the teachings of Haslam, which requires the motion sensor 38 to be mounted in a chamber 34 below the lamp shade. (See Fig. 4 and col. 3 lines 51-66 of Haslam). Accordingly, since Haslam fails to teach frame base framing a bottom panel and mounted to a base plate as required by claim 9, and further since Haslam fails to teach a motion detector assembly mounted to the base plate and positioned within the lamp shade, both required by claim 9, the combination of references cited in the instant office action do not teach or disclose each limitation thereof. Accordingly, claim 9 can not be rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Batko, Chien and further in view of Haslam.

Claim 10 also stands rejected as being obvious under 35 U.S.C. 103(a) over Cheng in view of Batko, Chien and Haslam for the reasons set forth with respect to claims 5 and 8. However, claim 10 depends from claim 8 and contains all the limitations thereof, and the further limitation that the bottom panel is partitioned into a plurality of

Appl. No. 10/799,464 of Sibalich et al.
Atty. Dkt. No. ZM466-04004

individual panels. For all the reasons set forth with respect to claim 9 above, claim 10 can not be rejected as obvious under 35 U.S.C. 103(a) over Cheng in view of Balko, Chien and further in view of Haslam.

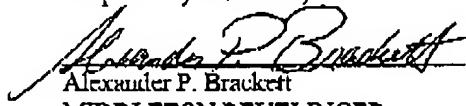
Claims 23-25 also stand rejected as being obvious under 35 U.S.C. 103(a) over Cheng in view of Balko, Chien and Haslam for the reasons set forth with respect to claims 5, 18 and 23. However, for all those reasons set forth herein above with respect to claims 5 and 18, claims 23-25 (which depend from claim 18) can not be rejected as obvious under the combination of references cited, since these references do not teach or suggest each limitation thereof.

Based on the foregoing arguments, applicant hereby requests the withdrawal of all obviousness rejections set forth in the instant office action.

Summary

Applicant has responded to each ground of rejection set forth in the instant office action and believes all claims to be in condition for allowance. Applicant hereby courteously solicits the allowance of all claims and the prompt passage to issue of the instant application. If the Examiner believes there are other unresolved issues in this case, applicant's attorney would welcome a telephone call at (502) 584-1135 to discuss such remaining issues.

Respectfully submitted,


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